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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/728,000	12/01/00	COMER R	MS#39124.2/4

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HOMER L. KNEARL
MERCHANT & GOULD P C
PO BOX 2903
MINNEAPOLIS MN 55402-0910

EXAMINER
FEILD, J

ART UNIT	PAPER NUMBER
2176	10

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

	Office Action Summary	**Application No.** 09/728,000	**Applicant(s)** COMER ET AL.	
		Examiner JOSEPH H FEILD	**Art Unit** 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *18 June 2001* .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-60* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-60* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on *01 December 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Reissue Applications

This reissue application was filed without the required offer to surrender the

original patent or, if the original is lost or inaccessible, an affidavit or declaration to that

effect. The original patent, or an affidavit or declaration as to loss or inaccessibility of

the original patent, must be received before this reissue application can be allowed.

See 37 CFR 1.178.

This application is objected to under 37 CFR 1.172(a) as the assignee has not

established its ownership interest in the patent for which reissue is being requested. An

assignee must establish its ownership interest in order to support the consent to a

reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is

established by:

(a) filing in the reissue application evidence of a chain of title from the original

owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is

recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed

by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be

submitted in reply to this Office action.

In the instant reissue, applicant has failed to specify the frame and reel number.

The reissue oath/declaration filed with this application is defective because:

(1) the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414. Applicant attempts to recapture subject matter surrendered during prosecution of the patent application upon which the present reissue is based. Thus, it appears that no reissuable error has been identified.

(2) the oath/declaration by the inventors does not include the statement "all errors being corrected in the reissue application up to the time of the filing of the oath or declaration arose without any deceptive intention on the part of the applicant". See See 37 CFR 1.175(a)(2) and MPEP § 1414.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed. The supplemental oath/declaration must include a different specific error that qualifies as a reissuable error.

Claims 1-60 are rejected as being based upon a defective declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Further regarding the issue of recapture, in new claim 39 (and similarly in claims 57 and 59), the limitation that broadens the claim is as follows: "identifying a list of completed data items from a search region with the spreadsheet, said search region including one of (1) cells sharing the same column as the active cell, (2) cells sharing the same row as the active cell, (3) cells within the same column as the active cell and within a range of N cells from the active cell, wherein N is an integer, and (4) cells within

the same row as the active cell and within a range of N cells from the active cell, wherein N is an integer".

The corresponding limitation in claim 1 of the patent is as follows: "identifying a list of completed data items from a search region within said spreadsheet comprising a table of contiguous data-containing cells encompassing said active cell and bordered by empty cells".

The language that constitutes broadening is the deletion of the limitations "bordered by empty cells" and "contiguous data-containing cells encompassing said active cell". Additionally, if "N" equals zero, the language is rendered broader still. Since the claim does not specify that "N" is greater than zero, then the claim can be interpreted to read on "N" being equal to zero.

It is noted that in prosecution of the application (08/658,798), which matured into the patent (5,845,300), the claims initially before the examiner did not include the "identifying" step. It is abundantly clear from the record that the claims were amended to overcome the prior art rejection. In amendment B of application 08/658,798 (paper #8), applicant amended the claims to include the "identifying" step in addition to other limitations. At pages 13-14 of the same amendment, applicant identified the newly added limitation in bold-faced lettering, and stated that "none of the references cited, alone or in combination, describe identifying a list of completed data items from a search region within a spreadsheet as recited by amended claim 1". Applicant further elaborated on this limitation as compared to the references relied upon by the examiner in rejecting the claim.

Receipt of an appropriate supplemental oath/declaration under 37 CFR

1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable

language to be used in the supplemental oath/declaration is as follows:

> "Every error in the patent which was corrected in the present reissue application, and is not covered by
> a prior oath/declaration submitted in this application, arose without any deceptive intention on the part
> of the applicant."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

Claims 39-46, 50-54, 56-60 are rejected under 35 U.S.C. § 103(a) as being

unpatentable over Smith, Do It Yourself Databases, MacUser, v.9, n.11, p.126(8), 11/93

in view of Novell, Quattro Pro User's Guide, 1994 and Sullivan, Intuit's Upgrade
Quickens Pace of Personal Finance, MacWeek v.7, n.29, p.52(2), 7/19/93.

- With respect to independent claims 39, 57, and 59 (and dependent claims 58 and
  60), Smith shows

    identifying a list of completed data items from a search region is
    shown third page "searches the database for previous entries". Smith
    covers the case where N equals zero.

    defining partial data entry within active cell is shown third page "that
    match the string of characters you're entering";

    *identifying a matching completed data item . . . that corresponds to
    said partial data entry* is shown in Smith's third page-- "completes the
    entry for you";

but does not show *displaying said matching completed data item as a suggested
completion, receiving an acceptance command in association with said
suggested completion,* and *in response to said acceptance command, storing
said partial data entry with said suggested completion within the active cell.*
However, refer to Sullivan's 2nd page, in which he discloses the QuickFill feature,
"which provides a prediction feature during transaction entry . . . . As you type
into a transaction entry or an editing window, QuickFill attempts to match the first
letters of what you are typing with previous entries and fills in the rest of the field
for you. If it's not correct, you just keep typing until it displays the correct
completion (or until you're finished typing, for a new entry)". Smith also fails to
show use in a spreadsheet application. Novell shows use in a spreadsheet
application in an analogous art for the purpose of data entry. It would have been

obvious to a person of ordinary skill in the art at the time the invention was made to apply Novell's use in a spreadsheet application to Smith because of Novell's taught advantages of data entry. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Sullivan with Smith because Sullivan states at the 2nd page that QuickFill is similar to the Clairvoyance feature that Smith discusses.

- With respect to dependent claims 40 and 41, Sullivan shows

> *receiving and operating on pertinent response* and
>
> *storing suggested completion if accepted* and
>
> *verifying suggestion modification to suggested completion* and
>
> *displaying partial item if suggested completion is rejected* is shown

third page description of QuickFill.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply Novell's use in a spreadsheet application and Sullivan's Quickfill application to Smith because of Novell's and Sullivan's taught advantages of data entry.

- With respect to dependent claim 42, Sullivan shows

> *defining cell range associated with active cell* and
>
> *retrieving completed data items from cell range forming associated*

list are shown in the description of QuickFill;

Smith shows

> *filtering list* and
>
> *sorting filtered list* is shown by use of Panorama's table look up.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply Novell's use in a spreadsheet application and

Sullivan's Quickfill application to Smith because of Novell's and Sullivan's taught advantages of data entry.

-       With respect to dependent claim 43, Novell shows

> *positionally basing association and selecting block of contiguous cells coterminous with active cell* is shown in the description of SpeedFill.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply Novell's use in a spreadsheet application and Sullivan's Quickfill application to Smith because of Novell's and Sullivan's taught advantages of data entry.

-       With respect to dependent claims 44 and 45, Smith shows

> *row or column restriction* is notoriously well known and therefore obvious in spreadsheets.

-       With respect to dependent claim 46, Smith shows

> *removing duplicates from associated list* is an embodiment of well known data compression in data base arts.

-       With respect to dependent claim 50-53, Novell shows

> *defining a data entry mask* and
>
> *searching completed items for match* and
>
> *equating suggestion to match* are shown in the description of SpeedFill.
>
> *deferring ID of completion if more than one match* and
>
> *disabling search if no match found* and
>
> *reenabling search after disablement* is an obvious embodiment of error trapping and clearing.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply Novell's use in a spreadsheet application and Sullivan's Quickfill application to Smith because of Novell's and Sullivan's taught advantages of data entry.

- With respect to dependent claim 54, Smith shows

    replacing with suggestion is shown third page.

- With respect to dependent claim 56,

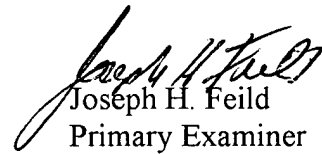   *case conversion* is a notoriously well known data base practice.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Feild whose telephone number is (703) 305-9792. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703) 746-7238   **(After Final Communication)**

(703) 746-7239   **(Official Communication)**

(703) 746-7240   **(For Status Inquiries, draft communication)**

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Joseph H. Feild
Primary Examiner
Art Unit 2176

11/5/01